



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,330	01/05/2001	Yuan-Chieh Lee	EM/LEE/6394	3663

7590 05/20/2004  
BACON & THOMAS  
625 Slaters Lane - 4th Floor  
Alexandria, VA 22314

EXAMINER

MAURO JR, THOMAS J

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/754,330

Applicant(s)

LEE, YUAN-CHIEH

Examiner

Thomas J. Mauro Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-7 are pending and are presented for examination. A formal action on the merits of claims 1-7 follows.

#### ***Specification***

2. The abstract of the disclosure is objected to because it contains legal phraseology, such as the word "said". Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

#### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show specific details of the invention, specifically a flow chart of the method steps and a figure showing details of the record file as described in the specification. These additional figures would allow one of ordinary skill to properly understand the invention without reading the complete disclosure, as is required. Any structural detail that is essential for a proper understanding of the disclosed

Art Unit: 2143

invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because they fail to show the necessary textual labels of the various features in Figure 1. Each element in Figure 1 must be labeled as described in the specification. A descriptive textual label for each numbered element in the figures would be necessary for one to fully understand the figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown and properly labeled in the drawings. See 37 CFR 1.84(n) and (o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2143

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Merriman et al. (U.S. 5,948,061).

With respect to claim 1, Merriman teaches a control system for agent websites to be used in an Internet system comprising:

at least one Internet user site equipped with an Internet accessible computer [Merriman - **Figure 1 item 16 and Col. 3 lines 24-28 – User, i.e. internet user site, accesses websites using internet capable device, i.e. computer or PDA**];

at least one promoting website to promote products, services and/or information in said Internet system and to provide at least one advertisement web page [Merriman -- **Figure 1 and Col. 2 lines 59-67 – Col. 3 lines 1-4 – Affiliate web page(s), i.e. promoting website, contains an advertisement webpage supporting third party advertisers showcasing products, services or information**];

at least one promoted website to allow transaction of products, services and/or information being promoted by said promoting website [Merriman -- **Figure 1, Col. 2 lines 61 and Col. 3 lines 18-23 – Advertiser's websites, i.e. promoted website, are accessed by a user "clicking through" or selecting the advertisement. This allows direct access to information and products or services directly from the advertiser**]; and

at least one agent website to control displaying and selection of advertisement information at said advertisement web page of said promoting website [Merriman -- **Figure 1, Col. 2 lines 60-61 and lines 66-67 and Col. 3 lines 12-15 and lines 52-57 – Advertisement**

Art Unit: 2143

**server site, i.e. agent website, determines which ad objects are to be transmitted to the user via the affiliate site];**

characterized in that said control system links said internet user site to said agent website after said internet user site is linked to said promoting website and said advertisement web page is provided to said internet user site, such that said agent website supplies a predetermined advertisement information to said internet user site and that said advertisement web page and predetermined advertisement information are displayed at said internet user site in combination [Merriman -- Col. 3 lines 5-63 – User accesses, i.e. links to, affiliate site, i.e. promoting site, and is transmitted the affiliate web page which includes links to the advertisement server site, i.e. agent site, to provide predetermined advertisement information to the user. This information is transmitted to the user and displayed by the web user's browser. Thus it is shown that links are created between the user and the affiliate site along with the advertising site];

that said control system requests said agent website to allocate a recording file in said internet user site or to create a recording file in said internet user site, if no recording file is allocated in said internet user site; wherein said recording file records at least address of said internet user site in said internet and data representing said predetermined advertisement information [Merriman -- Figures 3A, 3B and 3C, Col. 3 line 67 – Col. 4 lines 1-5 and lines 44-55 and Col. 5 lines 10-32 – Recording file, i.e. cookie, is either retrieved from the user or created on the user computer if none exists. This cookie is used to populate the database fields for tracking users, which includes such information as user ID and IP address along with advertising information, such as “Ads seen” and “Ads clicked on”]; and

Art Unit: 2143

that, when a selection instruction is input from said internet user site, said control system forwards said instruction to said agent website to actuate said agent website to pick up data in said recording file and links said internet user site to said promoted website to execute a purchase transaction [Merriman -- Col. 3 lines 64-67 – Col. 4 lines 1-11, Col. 5 lines 10-32 and Col. 7 lines 15-31 – Recording file, i.e. cookie, is forwarded to Ad site when a selection instruction, i.e. user input or “click through”, is actuated by the user clicking on an advertisement. A redirect command is then issued to cause the user to be redirected to advertiser, i.e. promoted website.].

With respect to claim 2, Merriman further teaches wherein data saved in said recording file comprises a membership number, a name, a birthday, a domicile area, sex identification, an email address or a domicile address [Merriman -- Figures 3A, 3B and 3C and Col. 4 lines 44-55 – Information collected from users include user ID's, i.e. name, domicile area, i.e. time zone, and domicile address, i.e. location of user].

With respect to claim 3, Merriman further teaches wherein data saved in said recording file comprises operation environment of said internet user site corresponding to advertisement information being displayed [Merriman -- Col. 3 lines 44-52 – Information sent to ad site, i.e. agent site, includes browser type and version along with the operating system of the computer].

With respect to claim 4, this is a method claim corresponding to the system claimed in claim 1. It has similar limitations; therefore, claim 4 is rejected under the same rationale.

With respect to claim 5, Merriman further teaches a step of importing data of said recording file and said selection instruction in said agent website when a selection instruction is input from said internet user site [Merriman -- Col. 3 lines 64-67 – Col. 4 lines 1-11, Col. 5 lines 10-32 and Col. 7 lines 15-31 – Recording file, i.e. cookie, is imported, i.e. received, by Ad site when a selection instruction, i.e. user input or “click through”, is actuated by the user clicking on an advertisement].

With respect to claims 6-7, these are method claims corresponding to the system claimed in claims 2 and 3. They have similar limitations; therefore, claims 6-7 are rejected under the same rationale.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Roth et al. (U.S. 6,285,987) discloses an Internet advertising system which transmits a cookie from a user site to a server to control the placement of advertisements.



- Musgrove et al. (U.S. 6,535,880) discloses an on-line commerce portal which provides shopping services to a user linking them to merchant sites for purchasing transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM  
May 13, 2004



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100